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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Coty US Inc. and Coty Cosmetics Inc.
v.
Frontier Cooperative Herbs

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Opposition No. 105,867
to application Serial No. 75/106,862
filed on May 20, 1996

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Herbert C. Ross, Jr. of Oppenheimer Wolf & Donnelly for Coty US Inc. and Coty Cosmetics Inc.

James C. Nemmers of Shuttleworth & Ingersoll, P.C. for Frontier Cooperative Herbs.

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Before Simms, Cissel and Seeherman, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Coty US Inc. and Coty Cosmetics Inc. (opposers) have opposed the application of Frontier Cooperative Herbs (applicant), an Iowa cooperative association, to register the mark LAVENDER FIELDS ("LAVENDER" disclaimed) for massage oil, essential oils for personal use, and non-

medicated bath salts.[1] Both parties have taken testimony and submitted other evidence, and both parties have filed briefs. No oral hearing was requested.

In the notice of opposition, opposers assert that, since August 19, 1993, they have used the mark VANILLA FIELDS for women's cologne, perfume, skin soap, body lotion, talcum powder, body powder and bath powder; that they have registered this mark (Registration No. 1,838,962, covering women's cologne, perfume and perfume oil, issued June 7, 1994, Sections 8 and 15 filed; Registration No. 1,891,577, covering skin soap, body lotion, talcum powder, body powder and bath powder, issued April 25, 1995;[2] and Registration No. 2,099,934, covering cologne, issued September 23, 1997);[3] that opposers' mark is strong and well known; and that

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[1] Application Serial No. 75/106,862, filed May 20, 1996, based upon allegations of a bona fide intention to use the mark in commerce.

[2] The grace period for filing a Section 8 affidavit in connection with this registration expired on Oct. 25, 2001, and current Office records show that no Section 8 affidavit has been filed. Although the registration has not been officially cancelled as of this date, we shall not consider this registration as part of opposers' case. However, opposers have established common law rights in the mark for the goods set forth in this registration.

[3] The latter registration, covering cologne, was pleaded as an application in the notice of opposition and matured into a registration during the course of this proceeding. Another registration, Reg. No. 2,219,073, issued Jan. 19, 1999, was introduced during trial. It covers the mark VANILLA FIELDS SUMMER NATURALS ("VANILLA" and "NATURALS" disclaimed) for body mist, body lotion and shower gel.

applicant's mark LAVENDER FIELDS so resembles opposers' previously used and registered mark as to be likely to cause confusion, to cause mistake or to deceive.

In its answer, applicant has denied the allegations of the opposition, and has asserted that applicant has acquired rights from a prior user.[4]

Before turning to the merits of this case, we shall first deal with a procedural matter. On the day discovery closed, applicant filed a motion to amend its description of goods from that set forth above to "aromatherapy products utilizing all natural essential oils consisting of massage oil, essential oils for personal use, and non-medicated bath salts." Opposers objected to this motion at the time and in their brief on the case, arguing that the motion was untimely and prejudicial. Opposers contend that they relied on the published description of goods during discovery and conducted discovery on that basis. Opposers argue that they would have asked different discovery questions if applicant's goods had been identified differently, with greater emphasis on the "aromatherapy" aspect of the goods. Opposers also indicate that they objected to some of applicant's questions asked during discovery when

[4] There is no testimony or other evidence on this "defense."

applicant attempted to seek information from witnesses concerning aromatherapy products. They state that they were not aware of applicant's desire to amend its description of goods until the motion to amend was filed.

Applicant, on the other hand, argues that its motion is justified and that distinctions between the goods of the parties have been the focus of numerous discovery requests and deposition questions prior to the filing of the motion.

The Board deferred ruling upon applicant's motion until after trial. In so doing, the Board told applicant that it should have advised opposers of its intention to amend earlier in the proceeding. However, the Board reopened opposers' testimony period in order to minimize any possible prejudice.

We agree with opposers that applicant's motion to amend, coming on the last day of discovery, was untimely. The motion was filed at a time that precluded opposers from conducting further discovery focused on the aromatherapy aspect of applicant's goods. We think that the proposed description may have been a significant factor in the way opposers may have framed their discovery. To grant applicant's motion would, therefore, be prejudicial to opposers. Accordingly, applicant's

motion to amend is denied. We should point out, however, that even if we had granted the motion and considered this case on the basis of the restricted description of goods mentioning aromatherapy products, it would not have changed the outcome we reach herein.

Opposers' Business

Coty Cosmetics Inc., a wholly owned subsidiary of Coty US Inc., is a manufacturer of fragrance and cosmetic products. VANILLA FIELDS perfume and cologne have been sold by Coty US, the user of the mark, since August or September 1993. The next year such goods as bath and shower gel, body lotion, milk bath, bath crystals, body mists, bath powder or talc, body soap and body wash were added to the line. The mark is also used in connection with potpourri and candles. Opposers' VANILLA FIELDS products are sold in department stores, drugstores, supermarkets and mass merchandisers. Over the years opposers have sold over $150 million in VANILLA FIELDS products. Opposers' VANILLA FIELDS products have been advertised in consumer magazines and on national and local television. Opposers' senior vice president of market development testified that VANILLA FIELDS is "a very successful brand" (Mary Manning dep., 60) and was

the most successful mass brand launched in 1993 in women's fragrances. *Id*., 71.

In early 1999, opposers introduced APRIL FIELDS cologne spray, body lotion and shower gel. This product is also sold in mass-market outlets and in drugstores. Opposers filed an application to register this mark in November 1997. In June 1999, opposers filed an intent-to-use application seeking to register the mark EXOTIC FIELDS. Opposers sell essential oils under other marks, but not under the VANILLA FIELDS mark. According to opposers' witnesses, essential oils are used in fragrance products and can be applied to the skin or may be diluted to make cologne or placed in bath water.

Opposers' VANILLA FIELDS labels include trade dress of stalks of vanilla, and opposers' advertising has used a green hummingbird. Opposers' witnesses have testified that opposers' competitors sell aromatherapy products and that the trend in the personal fragrance industry is to sell products labeled with the term "aromatherapy." Gray dep., 22-23. Opposers also sell a lavender body cream under a different mark. There have been no known instances of actual confusion between the respective marks.

Concerning the question of likelihood of confusion in this case, the senior vice president of marketing for the Coty brand, Mr. Arthur Sherwood, testified, at 51-52:

> A. We're prosecuting this proceeding because we see a strong likelihood of confusion of Lavender Fields with Vanilla Fields.
>
> If you'd like me to go further, the name "Fields" on both of them is very disturbing because what they do is, vanilla is an ingredient and lavender is an ingredient, vanilla is a scent as well as lavender is a scent that precede[s] the word "Fields." And that is very, very, very disconcerting to us because the likelihood of confusion, especially because of the fact that Vanilla Fields has a line of products-—April Fields right now coming out with Exotic Fields-— any one who's going into a store and would see these brands together would say, "Wow, April Fields, Vanilla Fields, Lavender Fields? That's likely the same company and, therefore, I'm going to try that product."
>
> The problem is, I have control over Vanilla Fields and April Fields, but I have no control over the scent or the quality control or anything else of something called Lavender Fields.

Applicant's Business

Applicant is a cooperative manufacturer and distributor that makes and distributes natural products including such personal care products as shampoos, lotions, conditioners, deodorants and soaps. Applicant's LAVENDER FIELDS products are a combination of three essential oils—-lavender, spike lavender and lavendin.

Applicant's LAVENDER FIELDS products were first shipped in June 1996.

Applicant now sells and distributes LAVENDER FIELDS body soaps, bath and shower gel, hand and body lotion, mineral bath, body oil and essential oils (although applicant is not seeking to register the mark for all of these goods). These products are sold in natural food stores as well as in the natural products areas of some supermarkets and drugstores.

Applicant's sales in 1999 exceeded $300,000. Although applicant is here only seeking to register the mark LAVENDER FIELDS, applicant's testimony reveals that the house mark "Aura Cacia" is always used with the mark LAVENDER FIELDS. Mr. Clinton Landis, applicant's aromatherapy marketing manager, testified that, at the time of adoption of applicant's mark, applicant had never heard of opposers' mark VANILLA FIELDS. There have been no instances of actual confusion, according to applicant's witnesses.

Mr. Landis also testified to the purchase at a mall of a line of third-party products sold under the mark DAFFODIL FIELDS. Those products include DAFFODIL FIELDS body lotion, body cream, body wash, fragrance spray, body splash, soap, mousse and various gels. Applicant also

made of record copies of third-party registrations of marks containing the word "FIELDS," including ELYSIAN FIELDS for such goods as facial soap and moisturizer and STRAWBERRY FIELDS for bath oil and bubble bath.

Opposers' Survey

Opposers also took the testimony of Mr. Walter McCullough, the president, CEO and survey research expert of Monroe Mendelsohn Research. Mr. McCullough testified that he has conducted over 50 likelihood-of-confusion surveys, 20-25 of which have been admitted into evidence. For this case, he designed and conducted a mall-intercept survey in eight shopping malls across the country. After asking the survey respondents (women) a screening question (whether they had purchased a fragrance, body or bath oil product selling for less than $25.00 in the last 12 months), the respondents were shown five cards with brand names and product descriptions. One of those five cards in the test group bore the trademark LAVENDER FIELDS and a description similar to the one in the application (although mentioning the word "aromatherapy"), and in the control group, the fictitious trademark LAVENDER MEADOWS with the same description. The four other cards in this first part of the survey were of so-called "disguise" products of relatively well-

known brands of shampoo, deodorant, bar soap and lipstick. These five cards were shown in different orders to eliminate any order bias.

In the second part of this survey, the survey respondents in both the test and the control groups were shown five other cards, two of which were identical to two of the cards in the first part of the survey, while two of the cards were different. The fifth card bore the trademark VANILLA FIELDS and the product descriptions in opposers' registrations. The card bearing the trademark VANILLA FIELDS was always placed in the last position.

The survey respondents (201 in the test group and 191 in the control group) were asked a question for each card shown in part two of the survey. The respondents were asked if the product shown on a particular card was the same brand or was made by the same company as the comparable product shown in the first part of the survey. If the respondent answered "no" or that she was not sure or did not know, she was asked the further question whether the product described in each of the five cards in turn was in some way affiliated or connected with the company that makes the comparable product shown in the first part of the survey.

After adding the "yes" responses to both of these questions and subtracting the control responses, the survey revealed 16 percent likelihood of confusion between the marks LAVENDER FIELDS and VANILLA FIELDS, which Mr. McCullough testified was "substantial."

During trial, applicant took the testimony of Mr. James Bernstein, the manager of domestic television research and a senior analyst at Frank N. Magid Associates, a research and consultation company. Mr. Bernstein stated that he was an expert in survey research design and execution. He raised a number of objections to opposers' survey: that there was no randomness in the selection of the survey respondents; that the respondents should have been screened for their knowledge about aromatherapy products, the effect of which was that persons knowledgeable about aromatherapy products were under-represented; the recency effect by which one is more likely to remember what was asked most recently, the VANILLA FIELDS card being shown last in the second part of the survey; that the critical question was "double-barreled" with more than one part to that question; that survey respondents were given "two bites of the apple," because those respondents who answered "no" or that they did not know or were unsure whether the product they were

shown was the same brand or made by the same company as that shown in the first part of the survey were asked a follow-up question concerning affiliation or connection, the effect of which was to increase reported confusion; and that the length of some of the descriptors (the LAVENDER FIELDS and LAVENDER MEADOWS product descriptions consisted of 28 words), had the effect of making the respondents take particular notice of those marks. It was Mr. Bernstein's conclusion that the survey results were not valid or credible.

In rebuttal testimony, Mr. McCullough responded that the survey design has been accepted by the courts; that it was proper to ask the so-called "double-barreled" question because the two questions were similar and not contradictory; that it was also not improper to ask a follow-up question because one does not have to think that the second product is of the same brand or is made by the same company in order for there to be a likelihood of confusion; and that, in any event, the control group responses should cure any possible problem with the survey or remove any potential bias. For example, Mr. McCullough points to the fact that in the control group the product description for the LAVENDER MEADOWS product was the same length as the product description of the

LAVENDER FIELDS product in the test group. Also, Mr. McCullough stated that if there were a recency effect in the second part of the survey, this would tend to reduce likelihood of confusion, not increase it.

Arguments of the Parties

It is opposers' position that the arbitrary and dominant part of the respective marks is the word "FIELDS," the first word in both marks being descriptive of an aroma and being disclaimed. Opposers also contend that they have a family of "FIELDS" marks including APRIL FIELDS, introduced in late 1998, for cologne, body lotion and gel. In view of this asserted family, opposers argue that consumers encountering applicant's mark may think that applicant's product is a fragrance extension of opposers' line of products.

As a result of the total sales of over $150 million and advertising and promotional expenses of $35 million, opposers also contend that the mark VANILLA FIELDS is "extremely famous". Brief, 31.

Whether or not applicant's identification of goods is amended, opposers' goods are closely related and in some cases identical to applicant's goods, opposers argue. Opposers contend that the goods of both parties are used for the same purposes because essential oils can

be used as perfume, and massage oils are moisturizers similar to opposers' body lotions. Further, opposers' bath crystals are similar to applicant's mineral bath, both furnishing an appealing fragrance. Opposers also point to similar natural promotional themes.

Concerning the channels of trade, opposers point to testimony that some of applicant's goods are in fact sold in chain drugstores, the same types of stores in which opposers' goods are found. Also, opposers observe that applicant mostly sells its goods through distributors over whom applicant has no control. In any event, opposers point to the lack of limitation on the channels of trade in the original as well as the proposed amended description of goods in applicant's application. In addition, opposers contend that there is no evidence to support applicant's arguments that its goods are sold to different consumers. Opposers also point to evidence that a number of competitors use the word "aromatherapy" on similar products and that those goods are sold in channels of trade similar to opposers'. Opposers also note that, because the respective products are inexpensive, consumers may be less likely to observe any differences in the marks.

While there is evidence of the use of a third-party mark (DAFFODIL FIELDS) for personal fragrance products, opposers argue that there is no evidence of the extent of this use. Also, the third-party registrations of record are for different goods than those involved in this case.

The lack of instances of actual confusion is explained, according to opposers, by the fact that here the respective products are in fact distributed in largely different channels of trade. Finally, any doubt on the issue of likelihood of confusion must be resolved in favor of opposers, they contend.

Concerning the survey, which showed a net confusion level of 16 percent, opposers argue that any flaws in the survey should only affect the weight it is accorded; that is to say, because the control group was asked the same questions, and since those results were subtracted from the results of the test group, any bias was eliminated. Opposers maintain that because likelihood of confusion involves both confusion as to affiliation or connection as well as to source, the separate questions asked of the respondents were appropriate. Opposers also point out that a similar survey was accepted in a published decision. Finally, opposers contend that applicant has not explained why any difference in the number of words

used to describe the products in the survey should influence the result. Opposers argue that if the additional wording caused respondents to spend more time on a particular question, that should have reduced the level of confusion demonstrated by the survey.

Concerning the issue of likelihood of confusion, it is applicant's position, on the other hand, that it is not possible to identify a dominant or a weak part of these marks. The weak word "FIELDS," according to applicant, is not capable of being a dominant element. Applicant argues that "VANILLA" conveys the meaning of an off-white color, which is dissimilar to the color conveyed by applicant's mark. In sum, applicant argues that the marks do not look or sound alike and that they evoke different visual images.

With respect to the goods, applicant contends that they are dissimilar and non-competitive. While applicant admits that some mass-market products are promoted using the word "aromatherapy," this is merely a "marketing tool" and these products do not use essential oils. Accordingly, applicant argues that this fact does not diminish the fact that a separate market exists for pure essential oil products like applicant's. Applicant contends that its products are in fact sold through

different channels of trade--natural product distributors and natural product stores--to a different class of consumers. It is applicant's position that its consumers are sophisticated and discriminating people who read labels and look for natural products while avoiding mass-market stores, large department stores and drugstores.

Applicant also notes the third-party DAFFODIL FIELDS line of personal care products sold at a nationwide retail outlet. Applicant maintains that this third-party use as well as third-party registrations show that the common use of "FIELDS" in trademarks is not likely to cause confusion. Applicant also points to the lack of evidence of actual confusion.

With respect to the survey, applicant contends that the results should not be admitted into evidence or, if properly analyzed, those results in fact support a finding of no likelihood of confusion. According to applicant, the survey was merely a test of short-term memory, included repetitive follow-up questions which served to inflate the appearance of confusion by giving respondents a chance to change their responses, should have included respondents who were knowledgeable about or who had purchased aromatherapy products, and contained

leading questions inadequately designed to show likelihood of confusion.

Discussion and Opinion

First, priority is not an issue here in view of opposers' ownership of registrations as well as testimony of opposers' first use. See *King Candy Co. v. Eunice King's Kitchen,* 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood-of-confusion issue. *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood-of-confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

There is no question that opposers' and applicant's personal care products are closely related goods. Opposers' perfume, perfume oil, body lotion and gel, and their bath crystals and milk bath are very similar to applicant's massage oils, essential oils and bath salts. Moreover, inasmuch as there are no restrictions in either applicant's or opposers' identifications of goods as to

purchasers or channels of trade, the Board must assume that applicant's goods could move through all the ordinary and normal channels of trade for such goods, and would be offered to all the usual purchasers for such products. See *Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990);* and *The Chicago Corp. v. North American Chicago Corp.,* 20 USPQ2d 1715 (TTAB 1991). Not only is there no restriction in applicant's application but also the record shows that applicant's goods can be found in some of the same channels of trade as opposers' goods, such as chain drugstores and some supermarkets. Also, the goods of the parties are not expensive. This fact, too, is a factor in opposers' favor on the issue of likelihood of confusion.

Turning to the parties' marks--VANILLA FIELDS and LAVENDER FIELDS—-these marks, while of course not identical, have obvious similarities. Both marks begin with a word which connotes a color and a type of plant. Both of those words are descriptive and have been disclaimed. They are each followed by the slightly suggestive word "FIELDS." Both marks have the same number of syllables.

Concerning the question of the strength of opposers' mark, we do not agree with opposers that this record supports a finding that their mark is a famous one. While it may have been the most successful new product in the year of its introduction (1993), and while opposers' personal care products sold under the mark have been the subject of substantial sales and advertising, we cannot conclude that the mark VANILLA FIELDS is famous. However, we determine that it is a relatively strong mark in the field and deserving of appropriate protection.

We also reject opposers' argument that it has a family of marks (VANILLA FIELDS and APRIL FIELDS). In order to establish a family, the plaintiff must show a public perception of the recognizable common or "family" element (the word "FIELDS") before the filing date of the application (or any earlier date that applicant can claim). See *Han Beauty, Inc. v. Alberto-Culver Co.,* 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). Here, the APRIL FIELDS products were introduced long after applicant's filing date and date of first use in 1996.

Applicant has provided evidence of a single third-party use—-the mark DAFFODIL FIELDS. We cannot say, however, that this limited evidence of the use of the term "FIELDS" by another would detract from the

likelihood that purchasers would attribute the same source to the parties' products.

Resolving any doubt that may exist, in accordance with precedent, in favor of the prior user and registrant, we conclude that one familiar with VANILLA FIELDS personal care products who then encounters LAVENDER FIELDS massage oils, essential oils and bath salts would think that these products are a line extension from the same source as the VANILLA FIELDS products.

Although opposers' survey tends to bolster the conclusion we reach, we have not given much weight to it. Among other things, we note that the level of confusion shown was not great and that the survey involved, in our view, too much of a memory test that may have led to guessing on the part of the survey respondents.

Decision: The opposition is sustained and registration to applicant is refused.